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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,310	11/28/2005	Karin Hamsen	10191/3707	9585
26646 7590 11/18/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
GOODWIN, DAVID J				
ART UNIT		PAPER NUMBER		
2818				
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11/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,310

Applicant(s)

HAMSEN ET AL.

Examiner

DAVID GOODWIN

Art Unit

2818

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-22 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because figures 1, 2, 4, 5, and 6 are of such quality as to be almost indecipherable comprising only barely varying shades of black.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 20, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
3. Regarding claim 20.
4. The claim recites the limitation "a completely sealed housing" in line 16.
5. There is insufficient support for this limitation in the specification or figures as originally filed.
6. Regarding claim 21.
7. The claim recites the limitation "no more than about 0.323 grams" in line 2.
8. There is insufficient support for this limitation in the specification or figures as originally filed.
9. Regarding claim 21.
10. The claim recites the limitation "no more than about 0.242 grams" in line 3.
11. There is insufficient support for this limitation in the specification or figures as originally filed.
12. Regarding claim 22.
13. Claim 22 depends from and incorporates claim 20 and 21.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 8, 11, 12, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le (US 6,160,309) in view of Terasaki (US 2002/0011661).
16. Regarding claim 8.
17. Le teaches a diode structure. Said structure comprises a diode (210). A press fit base (202) including an axially extending mounting region to mount a semiconductor chip (210). A head wire (204) provided with a head (205) configured to be affixed to the semiconductor chip. A stabilization arrangement, which includes at least a sleeve and an encapsulating material (206) filling cavities. Wherein the head wire together with the sleeve and the press fit base (202) forms a housing the cavities of which being filled with encapsulating material (206).
18. Le does not teach a stepped head.
19. Terasaki teaches press fit base having a head wire that includes a step (6c).
20. It would have been obvious to one of ordinary skill in the art to form a step in the head wire in order increase the stability of the connection and to prevent fall of insulating member.
21. Regarding claim 11.
22. Le teaches that the encapsulant (206) comprises epoxy (column 6 lines 5-15).
23. Regarding claim 12.
24. Le teaches that only the head of the head wire which is inside the housing is surrounded by encapsulating material (fig 2).

25. Regarding claim 13.
26. Le teaches that only the head of the head wire includes at least two regions having different diameters (fig 2).
27. Regarding claim 14.
28. Le teaches that the head wire is cone shaped (fig 2).
29. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le (US 6,160,309) in view of Terasaki (US 2002/0011661) as applied to claim 8 and further in view of Khandros (US 6,274,823).
30. Regarding claim 9.
31. Le in view of Terasaki teaches elements of the claimed invention above.
32. Le further teaches that the head wire is composed of copper (column 3 lines 15-25).
33. Le in view of Terasaki does not teach the lead wire is coated with nickel phosphorous alloy.
34. Khandros teaches coating a copper lead wire with nickel phosphorous alloy (column 6 line 60-column 7 line 5).
35. It would have been obvious to one of ordinary skill in the art to coat the copper wire with nickel phosphorous alloy in order to increase the yield strength and resiliency of the wire.
36. Regarding claim 10.
37. Le in view of Terasaki teaches elements of the claimed invention above.

38. Le further teaches that the head wire is composed of copper (column 3 lines 15-25).

39. Le in view of Terasaki does not teach the lead wire is coated with nickel phosphorous alloy.

40. Khandros teaches coating a copper lead wire with nickel phosphorous alloy (column 6 line 60-column 7 line 5).

41. It would have been obvious to one of ordinary skill in the art to coat the copper wire with nickel phosphorous alloy in order to increase the yield strength and resiliency of the wire.

42. Claims 16, 17, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le (US 6,160,309) in view of Terasaki (US 2002/0011661) in view of Khandros (US 6,274,823).

43. Regarding claim 16.

44. Le teaches a diode structure. Said structure comprises a diode (210). A press fit base (202) including an axially extending mounting region to mount a semiconductor chip (210). A head wire (204) provided with a head (205) configured to be affixed to the semiconductor chip. A stabilization arrangement, which includes at least a sleeve and an encapsulating material (206) filling cavities. Wherein the head wire together with the sleeve and the press fit base (202) forms a housing the cavities of which being filled with encapsulating material (206). Le teaches that the encapsulant (206) comprises epoxy (column 6 lines 5-15). Le further teaches that the head wire is composed of copper (column 3 lines 15-25).

45. Le does not teach a stepped head.
46. Terasaki teaches press fit base having a head wire that includes a step (6c).
47. It would have been obvious to one of ordinary skill in the art to form a step in the head wire in order increase the stability of the connection and to prevent fall of insulating member.
48. Le in view of Terasaki does not teach having a surface of the wire comprise nickel.
49. Khandros teaches coating a copper lead wire with nickel phosphorous alloy (column 6 line 60-column 7 line 5).
50. It would have been obvious to one of ordinary skill inn the art to coat the copper wire with nickel phosphorous alloy in order to increase the yield strength and resiliency of the wire.
51. Regarding claim 17.
52. Khandros teaches coating a copper lead wire with nickel phosphorous alloy (column 6 line 60-column 7 line 5).
53. It would have been obvious to one of ordinary skill inn the art to coat the copper wire with nickel phosphorous alloy in order to increase the yield strength and resiliency of the wire.
54. Regarding claim 18.
55. Le teaches that only the head of the wire which is inside the housing is surrounded by encapsulating material (206) and wherein the head includes two regions having different diameters (fig 2).

56. Regarding claim 19.
57. Le teaches that the head wire is cone shaped (fig 2).

Response to Arguments

58. Applicant's arguments filed 10/14/2008 have been fully considered but they are not persuasive.
59. The applicant argues that the Le reference does not disclose or suggest a stepped wire connection which together with the sleeve and press fit base form a housing (page 7).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further, Le teaches a housing as defined by the wire connection (204, 205) and the press fit sleeve (202) comprising a cavity which is filled with encapsulant (202) surrounding the head of the connector (205) (fig 2).

60. The applicant argues that the Terasaki reference does not disclose or suggest a stepped wire connection which together with the sleeve and press fit base form a housing (page 7).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

61. The applicant argues that the references do not concern a diode designed for stability in a motor vehicle (page 7).

62. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a diode used in a motor vehicle.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

63. The limitation must distinguish from the prior art in terms of structure rather than function, *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); See also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F. 2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

64. In response to applicant's argument that the prior art diode is not used in a vehicle, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

65. The applicant argues that the prior art does not refute the benefits provided by the claimed invention (page 7).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

66. The applicant argues that there is no motivation to combine the references (page 13).

67. The motivation for form a step adjacent to the head of the connector is to increase the stability of the connection. This motivation is derived from the teaching of Terasaki wherein it is made clear that a step (6c) formed at the head of a connector of a diode will improve the stability of the connection (paragraphs 0070-0071).

68. The applicant argues that the prior art applied does not refer to or operate in the same context of the problem addressed by the invention (page 7).

In response to applicant's argument that the prior art applied is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the field of endeavor is diodes which the Le and Terasaki

references clearly regard. The field of endeavor is not motor vehicles as the applicant contends.

69. The applicant argues that the examiner relied upon hindsight for the determination of obviousness (page 11).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

70. The applicant argues there is no suggestion or motivation to combine the prior art references.

71. The motivation for form a step adjacent to the head of the connector is to increase the stability of the connection. This motivation is derived from the teaching of Terasaki wherein it is made clear that a step (6c) formed at the head of a connector of a diode will improve the stability of the connection (paragraphs 0070-0071).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID GOODWIN whose telephone number is

(571)272-8451. The examiner can normally be reached on Monday through Friday, 9:00am through 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Loke can be reached on (571)272-1657. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Djg

/Steven Loke/
Supervisory Patent Examiner, Art Unit 2818